

Applicants: Ron S. Israeli, et al.
Serial No.: 08/403,803
Filed: March 17, 1995
Page 4

REMARKS

Claims 127-129 were pending in the subject application. Applicants have hereinabove canceled claim 127 without disclaimer or prejudice to applicants' right to pursue the subject matter of this claim in the future. In addition, applicants have amended claims 128 and 129. Support for the amendments to claims 128 and 129 may be found in the specification as originally filed at, inter alia, page 23, lines 9-29; page 22, lines 9-11; page 30, lines 5-11 and 29-33; page 31, lines 14-16; page 32, lines 24-32; page 53, line 20 to page 54, line 1; page 55, lines 5-16; SEQ ID NO:1; and Figs. 14-16. Applicants maintain that this Amendment raises no issue of new matter. Accordingly, applicants respectfully request entry of this Amendment. Upon entry of this Amendment, claims 128 and 129 will be pending and under examination.

Obviousness-Type Double Patenting Rejection

In the February 8, 2006 Office Action the Examiner rejected claims 127-129 as allegedly obvious over claims 1-13 of commonly assigned U.S. Patent No. 5,538,866 (the '866 patent) in view of Lerner.

In response, applicants respectfully traverse the Examiner's rejection. Initially, applicants note that claim 127 has been canceled above without disclaimer or prejudice. With regard to claims 128 and 129, applicants, in order to expedite prosecution, but without conceding the correctness of the Examiner's position, have amended claims 128 and 129. As amended, claim 128 is directed to an isolated nucleic acid which encodes "an outside region of prostate-specific membrane antigen, the amino acid

Applicants: Ron S. Israeli, et al.
Serial No.: 08/403,803
Filed: March 17, 1995
Page 5

sequence of which is set forth within SEQ ID NO:2 beginning with an amino acid corresponding to amino acid number 45 at its amino terminus and ending with an amino acid corresponding to amino acid number 750 at its carboxy terminus". Applicants maintain that such a nucleic acid is not obvious over claims 1-13 of U.S. Patent No. 5,538,866 (the '866 patent) in view of Lerner. Specifically, there is nothing in any one of claims 1-13 or in Lerner which would make it obvious to one skilled in the art to make a nucleic acid encoding an antigenic fragment having the sequence recited in claim 128 as opposed to a nucleic acid encoding any of the massive number of alternative fragments which might be contemplated.

The same reasoning applies to amended claim 129 which further recites a specific nucleic acid sequence.

Applicants maintain that the subject matter of amended claims 128 and 129 is not obvious over the '866 patent in view of Lerner et al. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

In the February 8, 2006 Office Action the Examiner also rejected claims 127-129 as allegedly obvious over claims 1-10 of U.S. Patent No. 5,935,818 (the '818 patent) in view of Lerner.

In response, applicants respectfully traverse the Examiner's rejection. Initially, applicants note that claim 127 has been canceled above without disclaimer or prejudice. With regard to claims 128 and 129, applicants, in order to expedite prosecution, but without conceding

Applicants: Ron S. Israeli, et al.
Serial No.: 08/403,803
Filed: March 17, 1995
Page 6

the correctness of the Examiner's position, have amended claims 128 and 129. As amended, claim 128 is directed to an isolated nucleic acid which encodes "an outside region of prostate-specific membrane antigen, the amino acid sequence of which is set forth within SEQ ID NO:2 beginning with an amino acid corresponding to amino acid number 45 at its amino terminus and ending with an amino acid corresponding to amino acid number 750 at its carboxy terminus". Applicants maintain that such a nucleic acid is not obvious over any one of claims 1-10 of U.S. Patent No. 5,935,818 (the '818 patent) in view of Lerner. Specifically, there is nothing in any one of claims 1-10 or in Lerner which would make it obvious to one skilled in the art to make a nucleic acid encoding an antigenic fragment having the sequence recited in claim 128 as opposed to a nucleic acid encoding any of the massive number of alternative fragments which might be contemplated.

The same reasoning applies to amended claim 129 which further recites a specific nucleic acid sequence.

Applicants maintain that the subject matter of amended claims 128 and 129 is not obvious over the '818 patent in view of Lerner et al. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 128 and 129 under 35 U.S.C. §112 as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner stated

Applicants: Ron S. Israeli, et al.
Serial No.: 08/403,803
Filed: March 17, 1995
Page 7

that the metes and bounds of the claims are indefinite as the claims recite "at least 15 consecutive nucleotides" and also recite "has a sequence which is the same as a sequence of all of an outside region of prostate specific membrane antigen".

In response, applicants respectfully traverse the Examiner's rejection. However, in order to expedite prosecution, but without conceding the correctness of the Examiner's position, applicants have hereinabove amended claim 128 and 129 so as to not recite the phrase to which the Examiner objected. Applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Summary

Applicants maintain that pending claims 128 and 129, as amended, are in condition for allowance. Accordingly, allowance of these claims is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

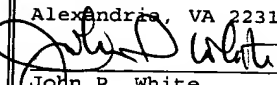
Applicants: Ron S. Israeli, et al.
Serial No.: 08/403,803
Filed: March 17, 1995
Page 8

No fee, other than the enclosed \$225.00 fee for a two-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Attorney for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF P.O. Box 1450 Alexandria, VA 22313-1450	
	7/10/06
John P. White	Date
Reg. No. 28,678	